



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,086	12/05/2003	Kevin Neil Kirn	MFCP.108796	7301

45809 7590 04/07/2005

SHOOK, HARDY & BACON L.L.P.
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

EXAMINER

WOODS, ERIC V

ART UNIT	PAPER NUMBER
----------	--------------

2672

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,086

Applicant(s)

KIRN ET AL.

Examiner

Eric V Woods

Art Unit

2672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

Examiner accepts the specification.

Drawings

Examiner accepts the drawings.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Curry et al (US PGPub 2003/0172116 A1)('Curry') in view of Biggs et al (US 2004/0172451 A1)('Biggs'). (Claims 1 and 11 are similar, simply a method and apparatus for performing the same task)

As to claims 1 and 11,

A system for selectively presenting media embedded in a message, comprising:

- An input interface to receive a media-enabled message; (Curry Fig. 1, element 122, "email program", see [0008-0010], communicated over network 106)(Biggs Fig. 2 – the "Recipients Browser" element 504 – and the "Pmail Recipient" 9 who retrieves the message using some kind of client program – see [0009-0014])
- A messaging client, communicating with the input interface, the messaging client presenting the media-enabled message to a user and permitting the user to select at

Art Unit: 2672

least one media object in the media-enabled message; and (Curry Fig. 1, element 122, “email program”, see [0008-0010])(Biggs Fig. 2 – the “Recipients Browser” element 504 – and the “Pmail Recipient” 9 who retrieves the message using some kind of client program – see [0009-0014])

-A media player, communicating with the messaging client, the media player presenting an enhanced representation of the at least one media object to the user. (Biggs in the cited browser 504 in Fig. 2, where the browser accesses the “Pmail data store” 7 to allow the user to display the full-sized or enhanced image – [0014-0020])(Curry [0008-0012] wherein it is stated that the user can play the attached audio or video file retrieved from a streaming server, as shown in Fig. 1 where 114’, 114, and 114” represent locations for streaming servers on the network, where the multimedia content from the sender or first client 102 is stored before being downloaded by second client 104—see [0030-0035])

Curry teaches all the limitations of the claim expressly except the ‘enhanced representation’ recited, given that Curry never states expressly that a detail of the message, e.g. some sort of thumbnail of a video or snippet of an audio message could be shown, whereas Biggs teaches that the user sees thumbnails of all available images and can choose which to download from a remote server, which clearly constitutes an “enhanced representation” which could be played back to a user. Further, it would be logical to assume that a video and/or audio clip could easily have a sample frame shown as a ‘thumbnail’ image as this technique is well-known in the art (Microsoft’s File Explorer within various versions of Windows has this functionality, in that it will show a

sample frame from a movie clip), and further that such a video clip or image could also have audio associated with it (indeed most video does). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the systems of Curry with that of Biggs for the aforementioned reasons and further because giving the user the ability to choose between clips – e.g. more easily select which attachment was desired – would allow the recipient of the email message to be more effective in determining which of the attachments was truly desired [0034, Curry], which also states that such embodiments can be web-based and also use embedded media players of the operating system or other functionality (Biggs [0012-0014]).

Curry teaches in Fig. 2A and in [0032-0033] that the message may contain a link indicating that the message has multimedia associated with it, particularly in [0034-0035], where it is disclosed that such links may be URLs within a browser to activate a location on a server, e.g. the streaming servers 114, 114', and 114'' in Fig. 1. Biggs also teaches HTML links in [0010], [0015-0017] and others so that the user can access the enhanced-resolution version of the thumbnail on the remote server.

As to claim 11, the only difference from claim 1 is slightly semantic, wherein letting the receiver select the desired object is set out as a separate step. This step is clearly taught by Biggs in [0011] where it is stated that the user is presented with a variety of thumbnails. The user must prima facie choose an image by clicking upon it to activate the HTML link in order to see the enhanced-resolution version; the same logic holds for the situation of the HTML links in Curry. Thusly, motivation / combination is the same as that of claim 1.

As to claims 2 and 12, Curry teaches email in [0008-0012] and Biggs teaches email in [0010] and [0015-0017], where emails are sent and received respectively. Motivation and combination is taken from claim 1.

As to claims 3, Curry teaches email programs in [0001-0004] and Biggs teaches email clients in [0002] and further details of email programs in general in, for example [0011] and [0016-0017]. Any email program is prima facie an email client if it allows the user to receive and send email as those recited programs do. Motivation and combination is taken from claim 1.

As to claims 4 and 13, Curry teaches media objects that are audio streams and video streams attached to emails, as in [0005] and particularly [0008-0010] where such is embedded in the program. Further, in [0028] Curry discloses that such emails may include images, and Biggs teaches in [0010-0016] the use of images in email with the sending of the thumbnails. Motivation and combination is taken from claim 1.

As to claims 5 and 14, Curry does not expressly teach this limitation, but does teach that emails can include images in [0028], whereas Biggs explicitly teaches this limitation in [0010-0017] where it is disclosed that the email contains thumbnail images and the user can, using a browser or other embedded application, access an enhanced-resolution version of the image, e.g. a typical resolution of 100x75 for thumbnails and 640x480 for "enhanced resolution" [0011-0012]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the

As to claim 6, Curry expressly teaches that the media playing capabilities of his player include audio and video [0008-0010]. Since only the primary reference is

Art Unit: 2672

utilized, no separate motivation or combination is required and that from the rejection to the parent claim is herein incorporated by reference.

As to claims 7 and 15, Curry teaches in Fig. 2A and in [0032-0033] that the message may contain a link indicating that the message has multimedia associated with it, particularly in [0034-0035], where it is disclosed that such links may be URLs within a browser to activate a location on a server, e.g. the streaming servers 114, 114', and 114'' in Fig. 1. Biggs also teaches HTML links in [0010], [0015-0017] and others so that the user can access the enhanced-resolution version of the thumbnail on the remote server. Motivation and combination is taken from claim 1.

As to claim 8, Curry clearly teaches in [0008-0011] that the media player is integrated with the messaging client. Motivation and combination is taken from claim 1.

As to claim 9, Curry clearly teaches that in [0033-0034] that external players can be used, e.g. Windows™ Media Player or QuickTime™ and that in certain embodiments those would be opened by clicking on a link that the browser program would then open and hand over to the media player (e.g. if the email were text only, and the link was opened by the browser automatically in response). Since only the primary reference is utilized, no separate motivation or combination is required and that from the rejection to the parent claim is herein incorporated by reference.

As to claims 10 and 16, Curry expressly teaches this limitation, as he teaches retrieving multimedia from the server, and given that images can be links within HTML, and Curry teaches images in [0028], that would be an obvious variant. Biggs does expressly teach this limitation in [0016-0018] where the user must go to the website to

Art Unit: 2672

retrieve the enhanced-resolution version. Specifically, the client of Curry that receives the email then communicates with the streaming server [0008-0009] to obtain the audio or video when the user activates the link. Motivation and combination is taken from claim 1.

As to claims 17 and 22,

A system for generating a media-enabled message, comprising:

- A selector module, the selector module permitting a user to selectively embed at least one media object in a media-enabled message; (Biggs [0012-0013] wherein in [0034-0036], particularly [0035], it is taught that the user can create an email message and select which pictures to upload to the central server and then provide thumbnails of)(Curry teaches that the user can choose at least one media object to embed within the email in [0008-0009]; further see Fig. 2A and 4A, where the multimedia is either embedded in or attached to the email respectively, and as can be seen in Fig. 7, the user has the option to "Select File" in the "Video Message Control Screen 706))
- An uploader module, communicating with the selector module, the uploader module publishing an enhanced representation of the at least one media object accessible to a recipient of the media-enabled message. (Uploader module exists in Curry in Fig. 2, element 206, where the media is uploaded to the server – see [0008-0012] again)(Biggs clearly teaches this limitation in [0009] and [0012-0013] where it is disclosed how these files are uploaded to the server and made smaller, e.g. see Fig. 2 wherein the Branded Client software 201 uploads the thumbnails and real images to Brand Pmail Server 5)

Art Unit: 2672

As stated in the rejection to claim 1 above, the Curry reference teaches all the limitations with respect to audio and video and the Biggs reference explicitly teaches images. Motivation and combination are taken from claim 1 and incorporated herein by reference in their entirety, with secondary motivation as stated in claim 1, wherein it would be an obvious and desirable variation for the user to be able to upload multiple objects with one messages, and it is known in the art that email programs allow multiple, if not unlimited, numbers of attachments, and further by generating the thumbnails from for example videos a user could ascertain more easily whether or not a video clip was desired (e.g. a video greeting card vs. various undesired videos of scenery that take up large amounts of space).

As to claims 18 and 23, these are substantial duplicates of claims 2 and 12; the rejection to those claims above is herein incorporated by reference in its entirety.

As to claims 19 and 24, these are substantial duplicates of claims 4 and 13; the rejection to those claims above is herein incorporated by reference in its entirety.

As to claims 20 and 25, these are substantial duplicates of claims 5 and 14; the rejection to those claims above is herein incorporated by reference in its entirety.

As to claims 21 and 26, these are substantial duplicates of claims 10 and 16; the rejection to those claims above is herein incorporated by reference in its entirety.

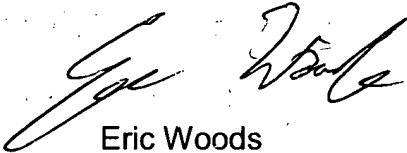
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric V Woods whose telephone number is 571-272-7775. The examiner can normally be reached on M-F 7:30-5:00 alternate Fridays off.

Art Unit: 2672


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi can be reached on 571-272-7664. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric Woods

March 28, 2005



JEFFERY A. BRIEN
PRIMARY EXAMINER